1752 AF/A

MS APPEAL BRIEF - PATENTS
Appl No: 09/374,989
Attorney Docket: 1982-0129P

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Toru MATAMA

Before the Board of Appeals
Appeal No.:

Appl No:	09/374,989	Art Unit:	1752
Filed:	August 16, 1999	Examiner:	Amanda C. WALKER

For: PHOTOGRAPHIC PHOTOSENSITIVE MATERIAL AND PHOTOGRAPHIC PRINTING SYSTEM

APPEAL BRIEF TRANSMITTAL FORM

MS APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

November 14, 2003

Sir:

Transmitted herewith is an Appeal Brief (in triplicate) on behalf of the Appellants in connection with the above-identified application.

☐ The enclosed document is being transmitted via the Certificate of Mailing provisions of 37 C.F.R. § 1.8.

A Notice of Appeal was filed on _____.

☐ Applicant claims small entity status in accordance with 37 C.F.R. § 1.27

The fee has been calculated as shown below:

☒ Extension of time fee pursuant to 37 C.F.R. §§ 1.17 and 1.136(a) - $110.00 - one (1) month (large entity)

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11/17/2003 JADD01 00000050 09374989

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Respectfully submitted,

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Attachment(s)

(Rev. 09/30/03)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Toru MATAMA	Appeal No.:	
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APPEAL BRIEF ON BEHALF OF APPELLANT: TORU MATAMA

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

November 13, 2003

Sir:

This appeal is from the decision of the Examiner dated May 14, 2003 (Paper No. 17) finally rejecting claim 4, which is reproduced as an Appendix to this brief.

TABLE OF CONTENTS

I. Real Party in Interest

The name inventor in the subject is Toru Matama. The inventor has assigned his rights to the invention that is disclosed in the application and any patent that may issue therefrom to Fuji Photo Film Co., Ltd.

II. Related Appeals and Interferences

To the best of the knowledge of the undersigned, there are no other appeals or interferences known to the appellant, the appellant's representatives, or the above-noted assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. Status of Claims

Claim 4 is presently pending in this application and is subject of the present appeal. Claims 2 and 3 have been previously canceled.

IV. Status of Amendments

No new amendment has been submitted after final.

V. Summary of the Invention

The present invention relates to a photographic photosensitive material on which an image is recorded and a photographic printing system which carries out printing processing based on the image recorded on the photographic photosensitive material, such as a negative film. The present invention as claimed allows for cheaper processing and development of images recorded on photosensitive materials.

Conventional color negative films include color sensitive emulsion layers containing couplers that are sensitive to blue, green, and red light. More specifically, a blue-sensitive emulsion layer produces a yellow dye, a green-sensitive emulsion layer produces a magenta dye, and a red-sensitive emulsion layer produces a cyan dye. These emulsion layers are layered on a film base. *See specification, page 1, lines 13-19.*

Typically, there are two issues in color printing processing - color correction and sharpness enhancement. First, color correction may be needed due to the dyes absorbing a different or unwanted spectrum of light. While the dyes that produce magenta and cyan dyes are primarily designed to be sensitive to green and red light respectively, these dyes are

also sensitive to and therefore absorb small amounts of other types of light as well. This unwanted light absorption results in deterioration of color reproduction. *See specification, page 1, lines 20-24.* To counteract this effect, additional colored couplers are included into the negative film so that the results of unwanted light absorption are masked and eliminated.

Second, sharpness (or edge) enhancement may be performed via the inclusion of a development inhibitor releasing (DIR) coupler in the negative film. During color development of the three emulsion layers, the development of an image in one layer may cause unwanted formation of dye in an adjacent emulsion layer. The DIR coupler suppresses this development and is known as the interimage effect. *See specification, page 2, line 19 - page 3, line 10.*

However, the inclusion of both types of couplers - color couplers for color correcting and DIR couplers for sharpness enhancement - is costly and unnecessary in some circumstances. For instance, the advent of digital printing systems allows development of images recorded on photographic films. The images may be obtained by a CCD scanner, the obtained image may be processed, and the processed image may be printed. Various

types of corrections may be carried out during image processing. *See specification, page 3, lines 17-24.* Thus, the digital data processing allows one or both types of couplers to be eliminated in the photosensitive material, and thereby reduce costs.

Accordingly, in one aspect of the present invention, a photosensitive material 22, such as a negative film, is **dedicated for digital data processing.** The photosensitive material 22 may or may not include a color coupler for the color correcting function. Likewise, the photosensitive material may or may not include a DIR coupler for sharpness enhancement function.

As recited in claim 4, the photosensitive material 22 does **not** include both the color coupler and the DIR coupler **at the same time.** *Emphasis added.* In other words, at most, the photosensitive material 22 can include **only one** of either the color coupler or the DIR coupler. *See specification, page 13, lines 7-12.* In this manner, the cost of the photosensitive materials can be reduced. *See specification, page 7, lines 2-11.*

Whether the photosensitive material includes one or the other of the color coupler and the DIR coupler may be recorded as an identification code 190 on the photosensitive material.

See Figure 6; specification, page 13, lines 7-12. The recording may be done optically or magnetically or on the cartridge accommodating the photosensitive material. *See specification, page 13, line 13 - page 14, line 8.* As indicated above, the identification code is used to determine that the photosensitive material has no color coupler or no DIR coupler or has neither color coupler nor DIR coupler.

VI. Issues

The following are the issues presented for appeal:

Whether claim 4 is properly rejected under 35 U.S.C. §103(a) as being obvious over Bohan et al. (U.S. Patent No. 5,837,433, hereinafter "Bohan") in view of Suzuki et al. (U.S. Patent No. 6,094,218, hereinafter "Suzuki"); and

Whether claim 4 is properly rejected under 35 U.S.C. §103(a) as being obvious over Bohan in view of Nair et al. (U.S. Patent No. 5,753,426, hereinafter "Nair").

VII. Grouping of Claims

Claim 4 is the only claim for appeal.

VIII. Argument

The Examiner rejected claim 4 as being obvious over a combination of Bohan and Suzuki and as being obvious over a combination of Bohan and Nair.

For a Section 103 rejection to be proper, a *prima facie* case of obviousness must be established. *See M.P.E.P. 2142.* One requirement to establish a *prima facie case* of obviousness is that the prior art references, when combined, must teach or suggest all claim limitations. *See M.P.E.P. 2142; M.P.E.P. 706.02(j); In re Vaeck, 20 USPQ2d 1438 (Fed. Cir. 1991).*

Appellant has asserted, as evidenced in the Amendments submitted on Reply filed on June 18, 2002, ("hereinafter June 2002 Reply") and March 4, 2003 (hereinafter "March 2003 Reply") that the cited prior art fails to teach or suggest all the claim limitations, and therefore an obviousness rejection cannot be substantiated and the rejection must be withdrawn.

A. **Combination of Bohan and Suzuki Does NOT Teach or Suggest Prohibiting Color Coupler and DIR Coupler at the Same Time**

In rejecting claim 4 under the combination of Bohan and Suzuki, the Examiner stated that Bohan teaches "a silver halide photographic material having a color correction function due to a masking coupler and/or a DIR coupler, and intermage effects and for an alternative method of processing such a material which includes a step of digital manipulation to produce a color corrected image." The Examiner admitted that Bohan "fails to teach a material having a bar code in it or on the cartridge encasing it." *See Final Office Action of May 14, 2003 ("hereinafter Final Office Action"), page 3, lines 10-15.*

To correct for this deficiency of Bohan, the Examiner asserted that Suzuki discloses a film cartridge having a bar code and the bar code may include information such as the type or variety of the film. *See Final Office Action, page 3, line 16-20.*

The Examiner then took a position that one of ordinary skill would be motivated to record detailed "type or variety of film" information in the bar code as disclosed in Suzuki so that

information is available via a reading device. *See Final Office Action, paragraph beginning on page 3, line 16.* Then the Examiner concluded that it would have been obvious to encase the photosensitive material of Bohan in a cartridge containing a bar code as disclosed in Suzuki such that the film information contained by the bar code is of information useful during digital processing for that specific material.

However, the Examiner failed to directly address a particular issue raised in the March 2003 Reply. That is, the Examiner failed to address Appellant's argument that neither Bohan nor Suzuki teaches or suggests the feature of "photosensitive material either has said color correcting function or said sharpness enhancing function, and … said photographic photosensitive material does not contain a colored coupler for said color correcting function and a DIR coupler for said sharpness enhancing function **at the same time**." *See March 2003 Reply, pages 3-8.*

Appellant has previously raised similar issues in other replies. For example, in the June 2002 Reply, Appellant argued that neither Bohan nor Suzuki teaches or suggests an identification code which expresses that the photographic

sensitive material either has **only one or none** of a color correcting function and a sharpness correcting function. *Emphasis added; See June 2002 Reply, pages 5-6.*

As noted above, to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be **taught or suggested** by the prior art. *Emphasis added; In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *See also MPEP 2143.* In this instance, the Examiner simply failed to show a line of reasoning as to how the combination of Bohan and Suzuki teaches or suggests the above-noted feature.

Appellant respectfully submits that the Examiner failed to directly address the particular issue noted above simply because Bohan and Suzuki may not be combined to show such a feature. As noted previously, Bohan discloses conventionally processing photographic materials to develop a negative film. The Examiner admitted Bohan discloses the photographic material may contain a DIR coupler to aid in increasing sharpness of the material. *See Final Office Action, page 2, paragraph 2.* The Examiner also readily admitted that Bohan discloses the photographic material may include color masking couplers to enhance color processing of the images. *See Final Office Action, page 2, paragraph 2.*

In other words, the Examiner admitted, correctly, that **the presence of both** color masking and DIR couplers, **are possible** as disclosed in Bohan. However, the Examiner did not show, indeed cannot show, that Bohan teaches **prohibiting** both couplers from being present at the same time. Suzuki has not been, and indeed cannot be, relied upon to correct at least this deficiency.

Also, in the Office Action dated October 4, 2002 (hereinafter "October 2002 Office Action"), the Examiner stated the following (subsequently reemphasized in the Final Office Action on page 6, first paragraph):

> the material of Bohan et al. teaches a silver halide photographic material having a color correction function due to a masking coupler and/or DIR coupler, interimage effects, and for an alternative method of processing such a material which includes a step of digital manipulation to produce a color corrected image. It is *believed* that since this type of material includes a unique processing step, a cartridge containing the film, which has a bar code, would include information about this unique step. *Emphasis added.*

However, according to the standard stated in *In re Royka* and the MPEP, a Section 103 rejection requires that the prior art "teach" all the claimed features. Therefore, it is not enough for the Examiner to merely base a rejection on a "belief" that

something must be true without an actual teaching that it occurs in the art. Otherwise, the interpretation is unreasonably broad and therefore is improper.

To the extent that the statement made above by the Examiner goes to the question of motivation, the Federal Circuit has made it clear that the factual question of motivation is material to patentability and cannot be resolved on a subjective belief and unknown authority, but must be read on the objective evidence of the record. *See In re Lee, 61 USPQ2d 1430 (Fed. Cir. 2002).*

As shown above, the Examiner's assertions fail to show at least the above-noted feature of prohibiting both the color masking coupler and the DIR coupler from being present at the same time.

However, even if all of the Examiner's assertions are taken to be true, the combination of Bohan and Suzuki still cannot be combined to show the feature of prohibiting both the color masking coupler and the DIR coupler from being present at the same time. As noted above, and as admitted by the Examiner, Bohan discloses that both color couplers and DIR couplers may be included in the negative film. **The presence of both couplers actually teaches away from the present invention.**

Suzuki has been relied upon to merely suggest that information regarding the type of film and their characteristics may be recorded on a bar code. Taken the two together, at best, the references may be combined to show that a characteristic of the color coupler **and** DIR coupler materials of a negative film may be recorded on a barcode. Thus, even if the Examiner's assertions are taken at their face value, such a combination is not the invention. There is **no teaching or suggestion** in the combination of the references **of excluding the presence** of both the color masking coupler and the DIR coupler at the same time.

Therefore, the Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness.

B. **Combination of Bohan and Suzuki Does NOT Teach or Suggest a Photosensitive Material Dedicated to Digital Processing**

The Examiner relied upon Bohan exclusively to show a photosensitive material **dedicated** to digital processing. *See Final Office Action, page 6, lines 9-13.*

However, Bohan clearly shows otherwise. Bohan discloses that a film first undergoes photographic processing and the

resulting negative images may then undergo digital processing. Bohan specifically states "After this **photographic processing**, the color image thus formed … enable the subsequent color scanning step of the invention." *Emphasis added; See Bohan, column 7, lines 57-60.*

Bohan discloses that one type of photographic processing is disclosed in a patent to Pagano et al. (U.S. Patent No. 5,543,882, "hereinafter Pagano," and attached hereto as Exhibit A). *See Bohan, column 20, lines 39-42.* Pagano is directed to a method and apparatus of developing a photosensitive film contained in a cartridge. Pagano describes a novel method and apparatus in which the photosensitive film is not detached from the cartridge while the film is being processed. However, the actual process of developing the film itself is conventional. Pagano **is completely silent** regarding whether the film in the cartridge is dedicated to digital processing.

Indeed, Pagano suggests quite the opposite. For example, Pagano describes a cover assembly 28 which is designed to receive a photosensitive material and take it through the **photofinishing process.** *See Pagano, Figure 3; Pagano, column 3, lines 48-51.* Without more, one of ordinary skill would clearly

conclude that the photofinishing process, at a minimum, includes conventional processing to develop and print images.

Further, Pagano describes automating the process so that a computer within the device would be used to track the film during its development and **printing**. *See Pagano, column 7, lines 37-42.* Again, without more, the conventional printing process cannot be excluded. Clearly, the suggestion is that Pagano contemplates using photosensitive film for conventional print processing.

Thus, by specific reference to Pagano, which describes processing of photosensitive materials that are **not** dedicated to digital processing, Bohan cannot be relied upon to show a photosensitive material **dedicated** to digital processing.

In addition, the Examiner did not rely upon Suzuki to correct this deficiency of Bohan because Suzuki may not be so relied upon. Appellant notes that Bohan actually **teaches away** from the claimed invention to the extent that Bohan teaches inclusion of a photographic material that is **not** necessarily **dedicated** to digital processing (by reference to Pagano). Thus, Bohan may not be used as a proper basis of rejection.

Therefore, the Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness.

C. **Combination of Bohan and Nair Does NOT Teach or Suggest Prohibiting Color Coupler and DIR Coupler at the Same Time**

In the rejection of claim 4 under the combination of Bohan and Nair, the Examiner asserted that Bohan also teaches that the silver halide photographic material may contain any conventionally employed emulsion layers. *See Final Office Action, page 4, lines 13-15.* The Examiner also asserted that Nair discloses a silver halide photographic material containing a transparent magnetic recording layer capable of having information recorded thereon. Then, the Examiner simply concluded that it would have been obvious to one of ordinary skill to encase the photosensitive material of Bohan to include the transparent magnetic recording layer of Nair in which the film information is processing instructions for the specific material.

Again, the Examiner has **failed to directly address the particular issue** raised in the March 2003 Reply - namely that

neither Bohan nor Nair teaches or suggests the feature of "photosensitive material either has said color correcting function or said sharpness enhancing function, and … said photographic photosensitive material does not contain a colored coupler for said color correcting function and a DIR coupler for said sharpness enhancing function at the same time."

Like the rejection above with the combination of Bohan and Suzuki, the Examiner simply failed to show a line of reasoning as to how the combination of Bohan and Nair teaches or suggests the above-noted feature. Appellant submits that the Examiner failed to directly address the particular issue because Bohan and Nair simply may not be combined to suggest such a feature. In other words, neither Bohan nor Nair teaches or suggest **prohibiting** the color masking coupler and the DIR coupler from being present at the same time.

Also like the situation described above with Suzuki, even if all of the Examiner's assertions are taken to be true, the combination of Bohan and Nair at best suggests that a characteristic of **both** the color coupler **and** DIR coupler materials of a negative film may be recorded on the magnetic

recording layer. However, this **does not suggest** prohibiting both couplers from being present at the same time.

Therefore, the Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness.

D. **Combination of Bohan and Nair Does NOT Teach or Suggest Dedication to Digital Processing**

It has been shown above that Bohan may not be relied upon to teach or suggest a photosensitive material dedicated to digital processing. Nair cannot be relied upon to correct this deficiency. Indeed, Nair cannot be relied upon for this proposition and the Examiner has admitted to this implicitly. More specifically, the Examiner stated that Nair was relied upon "solely for its teaching of the magnetic layer that may be used in silver halide photographic film, not the film material itself." *See Final Office Action, page 6, line 21 - page 7, line 2.*

Therefore, Bohan and Nair cannot be combined to teach or suggest a photosensitive material dedicated to digital processing, and the Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness.

IX. Conclusion

For the reasons specifically set forth above, the outstanding rejections set forth in the Final Office Action should be REVERSED.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) respectfully petition(s) for a one (1) month extension of time for filing a reply in connection with the present application, and the required fee of $110.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional

fees required under 37 C.F.R. §§ 1.16 or 1. 17; particularly, extension of time fees.

Respectfully submitted,

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APPENDIX

The Appealed Claim

4. A photographic photosensitive material dedicated for digital data processing which has a color correcting function for carrying out color correction of an image which has been subjected to developing processing or a sharpness enhancing function for enhancing sharpness of the image which has been subjected to developing processing, wherein an identification code for digital processing is recorded optically or magnetically onto said photographic photosensitive material, or is recorded onto a storage element provided at a cartridge accommodating said photographic photosensitive material, said identification code expressing that said photographic photosensitive material either has said color correcting function or said sharpness enhancing function, and

when said photographic photosensitive material has said color correcting function, said color correcting function is due to at least one of a colored coupler and an interimage effect, or

when said photographic photosensitive material has said sharpness enhancing function, said sharpness enhancing function is due to a DIR coupler, and

said photographic photosensitive material does not contain a colored coupler for said color correcting function and a DIR coupler for said sharpness enhancing function at the same time.